Appl. No. 09/693,327
Amdt. dated June 2, 2006
Reply to Final Office Action of April 3, 2006

AFTER FINAL EXPEDITED PROCEDURE

REMARKS

Claims 1 to 15 were pending in the application at the time of final examination. Claims 1 to 15 stand rejected as obvious.

Claims 1 to 15 are newly rejected as being obvious, by U.S. Patent Application Publication No. 2002/0073106 A1, hereinafter referred to as Parker, in view of U.S. Patent No. 6,918,082 B2, hereinafter referred to as Gross, and further in view of U.S. Patent Application Publication No. 2004/0205340 A1, hereinafter referred to as Shimbo.

Applicant respectfully notes that the instant rejection stated "Applicant's arguments with respect to claims 1 to 15 have been considered but are moot in view of the new ground(s) of rejection." Applicant respectfully submits that this is incorrect and in fact, the final rejection is incomplete because Applicant's remarks were not considered:

The Final Rejection Repeated Verbatim The Earlier Rejection Based On Parker And Gross

The current rejection repeats verbatim the portion of the prior obviousness rejection based upon Parker and Gross, and then adds a third new reference with this combination. The third reference is used only to address the amendment made to the claims in the last response. Accordingly, the rejection of the original claim language is based solely on the combination of Parker and Gross. If the combination of Parker and Gross was not well founded, there is no basis for the rejection because the information from the third reference is not sufficient to overcome the deficiency of the combination of the two primary references.

Applicant demonstrated in the prior response that the combination of the two primary references was not well founded,

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but the final action failed to rebut these remarks and therefore the Office has admitted that these remarks are correct. Accordingly, the case should have been allowed.

If the Examiner disagrees, the record is incomplete because the remarks of Applicant demonstrating that the combination of the two primary references was improper have not been considered and so the final rejection is premature. Specifically, even though Applicant has multiple times pointed out that Parker taken as a whole teaches away from Applicant's invention as recited in Claim 1, the final rejection simply repeats the prior rejection without any indication as to why Applicant's remarks were not persuasive. Applicant further pointed out why the motivation for the combination of Parker and Gross was not well founded. Since the final rejection repeated verbatim the prior rejection based upon Parker and Gross, and failed to rebut Applicant's remarks with respect to the combination, the record is incomplete and the final rejection should be withdrawn as premature. There is no basis for the Appeals Board to determine why the Office did not consider Applicant's remarks persuasive.

The Obviousness Rejection Is Not Well Founded.

The MPEP directs:

BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:
(A) The claimed invention must be considered as a whole;
(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
(D) Reasonable expectation of success is the standard with which obviousness is determined.

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MPEP § 2141 II., 8th Ed., Rev. 23 p. 2100-125 (August 2005).
It is noted that this directive stated "the following tenets .
. . **must be adhered to**." Accordingly, failure to adhere to any
one of these tenets means that a prima facie obviousness
rejection has not been made.

The final rejection failed to adhere to multiple of these
tenets. As demonstrated more completely below, the claimed
invention has not been considered as a whole; the references
have not been considered as a whole; and the references do not
suggest the desirability of making the combination. Finally,
there was no explanation of how the primary reference would
work for its intended purpose following the multiple
unsupported modifications put forth in the final rejection that
directly contradict the teachings in the primary reference.

The Final Rejection Failed to Consider the References as A Whole

In addition to the above quoted directions from the MPEP,
the MPEP also directs:

> A prior art reference must be considered in its
> entirety, i.e., as a whole, including portions that would
> lead away from the claimed invention.

MPEP § 2141.02 VI, 8th Ed., Rev. 3, pg. 2100-132 (August 2005).

Thus, the MPEP requires "The references must be considered as a
whole and must suggest the desirability and thus the
obviousness of making the combination."

Parker Taught Storing A Current Version And A Delta

The teaching of Parker to store a current version and a
delta teaches away from

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storing said at least <u>one earlier version of said</u>
<u>document in its entirety in a file</u> on said storage medium;
and
<u>storing said current version of said document in its</u>
<u>entirety</u> in said file   (Emphasis added)

as recited in Claim 1. The Abstract of Parker stated:

. . . comparing the current version of a changed file
to the last previous on-site version of the changed file,
computing the differences between the two versions by
different forward and reverse algorithms to provide a
forward delta and a reverse delta, **storing the current**
version and the reverse delta of the changed file on-site
while deleting the last previous on-site version of the
changed file, permanently storing off-site the forward
deltas of each changed file and a baseline copy of each
new file, **restoring any requested file, if on-site, by**
recovering the current version and subtracting the
appropriate reverse deltas therefrom until the requested
file is produced, or, if off-site, by recovering the
baseline version and adding the appropriate forward deltas
thereto until the requested file is reproduced. (Emphasis
Added.)

The Abstract teaches nothing about storing two versions of
a document in a single file. In fact, a document is not even
mentioned. Further, the Abstract teaches or suggests nothing
about how the delta and the current versions are stored, except
that they are stored either on-site or off-site.
    First, two files are used by Parker and so Parker teaches
away from storing two versions in the same file. Second, a
current version and a delta were taught. Use of a delta
teaches away from storing versions in their entireties as
recited in Claim 1. Any modification of Parker to use other
than a delta goes against the teaching of Parker and as
discussed more completely below, would violate the object of
Parker to minimize storage. This is direct evidence that
Parker has not been considered as a whole.

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Further, Parker explicitly stated that both the current version and the delta had to be used to restore a requested file. In contrast, Claim 1 recites:

> retrieval of said at least one earlier version for said subsequent use is independent of a status of said current version

As quoted above from the Abstract of Parker, Parker could not do the retrieval if either the delta or the current version were missing or damaged. Accordingly, Parker is dependent on the status of both the current version and the delta and so further teaches away from Applicant's Claim 1. Any modification of Parker to use other than a delta and to change the status based on other than the status of the delta goes directly against this teaching of Parker and so is further evidence that Parker has not been considered as a whole as required by the MPEP.

In addition, Paragraph [0006] of Parker stated:

> [0006] It is a further object of the present invention to detect the precise changes made to a prior file in the system and then save the changes. An important step in this process is **computing the differences between the two previous and current versions to provide a forward delta and a reverse delta, and, then, storing the current version and the reverse delta of the changed file onsite while deleting only the last previous on-site version of the changed file, and permanently** storing off-site the forward delta of the changed file and a baseline copy of each new file. This process preferably uses different forward and reverse algorithms to compute the forward and reverse deltas. (Emphasis added)

This teaches nothing more than was noted above with respect to the Abstract and so the above comments with respect to the Abstract are directly applicable to this paragraph also and so will not be repeated. The teaching of storing a current version and a delta is fundamentally different from what is

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recited in Claim 1 and so teaches away from the invention.
Nevertheless, the rejection asserts that one of skill in the
art would look to Gross even though Parker clearly worked
efficiently for its intended purpose. Specifically, the
rejection stated:

> Gross teaches "wherein said at least one earlier
> version and said current version are both in said file for
> subsequent use" (see col. 2, lines 50-67 and col. 3, lines
> 1-9).

Gross Is Mischaracterized And In Fact Also Teaches Away

The sections of Gross cited in the rejection stated:

> The disclosed prior art systems and methodologies
> provide methods for the delivery of portable format
> documents over computer networks, but fail to provide a
> way to automatically display or track multiple versions of
> the electronic documents, to review and add to a history
> of comments about the particular version of the document
> displayed, to alter the current/preferred version of the
> document, or to simultaneously-display a particular
> document version and its current history. Nor do the
> disclosed prior art systems enable these capabilities for
> simultaneously managing multiple different projects and
> documents.

> SUMMARY OF THE INVENTION

> Accordingly, it is an object of the invention to
> provide a system which simultaneously displays multiple
> versions of portable format document over a computer
> network.
> Another object of the invention is to provide a
> system enabling a collaborative reviewer to change a
> current version of a portable format document.
> Still another object of the invention is to provide a
> system for simultaneously displaying a history of comments
> from collaborative reviewers together with each version of
> a portable format document.

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This section of Gross teaches nothing concerning the storage of different versions of a document and instead discusses display of versions of the document. Accordingly, the cited section fails to support the conclusions in the rejection and fails to suggest the explicit claim limitations.

Further, when Gross is considered as a whole, Gross also teaches away from the conclusions of the rejection. In Fig. 3, Gross shows that different versions of a document are stored as two files in two different directories, e.g. one version of MyFile 100 is stored in version one of directory 98 and another version of MYFile 101 is stored in version two of directory 98. This explicitly demonstrates that the two versions of the document are stored as separate files in different directories and so teaches away from Applicant's invention as recited in Claim 1.

Gross explicitly described this by stating:

> One or more client directories **94** are created in root **92**. The dots ". . ." indicate that there are multiple other possible **directories**. As alluded to above, a client is a unique group/collection of proofers. In this regard, it is understood that members of a client group may each have the same or different proofer identifiers.
>
> Each client **94** may be assigned multiple proofing projects **96** each of which is created in a separate directory. Whenever a document version is uploaded to computer **60 directories 94 and 96** are created if they do not already exist, a version number is assigned to the document and a **version directory 98** is created if necessary to store the document version. In the illustrated example, Client 1's Project 1 includes three different documents: MyFile, MyFile 1 and MyFile 2. The document named MyFile exists in two versions **100** and **101**. The document named MyFile 1 exists in a single version **102**. And the document named MyFile 2 exists in two versions **103** and **104**. Thus, these three documents comprise five different document versions. It is understood that although not necessary to the invention, a project identifier is also sent to computer **60** when creator **56** uploads a document version.

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When a proofer requests a document version, the URL is assembled by combining the protocol and host "<protocol>://<host>" together with the directory tree structure assembled from the information about the document version "<client>/<version>/<name>". The complete URL takes the form "<protocol>://<host>/<client>/<project>/<version>/<name>/". Other specific forms are possible for the URL, but by setting up the directory tree with some information about the document and by formulating the URL from the directory tree, the URL also provides information about the document.

Gross, Col. 5, lines 33 to 65.

Accordingly, the interpretation of Gross in the final rejection is not supported by the reference. Since the interpretation given of the two references in the rejection is supported by neither of the references, the reliance upon the two references goes directly against the requirement of the MPEP as quoted above. The express teaching of using two files for different versions in Gross must be considered when Gross is considered as a whole. These facts alone are sufficient to overcome the obviousness rejection.

A Proper Motivation For Combining Parker And Gross Has Not Been Established.

The motivation for the combination of the first two references in the final rejection was:

It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Gross and Parker above, because using the steps "wherein said at least one earlier version and said current version are both in said file for subsequent use" would have given those skilled in the art the tools to store/process/display current or earlier versions of document in an individual file simultaneously. This gives users the advantage of manipulating the versions of various documents in a more efficient manner.

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Again, this motivation cites no teaching in the prior art to support the conclusions and instead uses Applicant's claim language.

The MPEP directs:

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION

MPEP § 2143.01, 8th Ed., Rev. 3, pp 2100-135 (August 2005).

The motivation provided is not based on any citation to the prior art and so the rejection has failed to establish that the prior art suggests the desirability of the claimed invention. Applicant's claim language is not in the prior art and so cannot be used as part of the motivation for the combination. Further, there has been no citation from the prior art that modifying Parker as suggested in the rejection would make Parker more efficient. A conclusory statement without support in the prior art fails to satisfy the requirements of the MPEP. Accordingly, a proper basis for the motivation has not been established.

This is further evidenced by the MPEP requirement:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

MPEP § 2143.01, 8th Ed., Rev. 3, pp 2100-137 (August 2005).

The two cited references establish the level of skill in the art and Parker teaches that the motivation is not well founded. In particular, Parked stated:

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It is an object of the present invention <u>to use</u>
<u>minimum storage</u> on-site and offsite by storing only a
baseline version of a document offsite with all forward
deltas and saving only the current version of the document
on-site with all reverse deltas. The volume and time to
transmit data to offsite storage and back to the on-site
host is kept to a minimum. (Emphasis added.)

Parker, paragraph [0005]

One of skill in the art in viewing Parker as a whole would be
looking to use minimum storage. Storing two complete versions
goes against minimizing storage and so would not be more
efficient as alleged in the rejection. Thus, the motivation
directly contradicts the teachings in the primary reference.
The proposed modification also goes against the explicit
teaching of storing only a single version and deltas, as
discussed above. Accordingly, one of skill in the art, in view
of Parker would not have the motivation used in the rejection.
This is further evidence that the references have not been
considered as a whole.

In addition, the MPEP directs:

< **THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART
UNSATISFACTORY FOR ITS INTENDED PURPOSE**
If proposed modification would render the prior art
invention being modified unsatisfactory for its intended
purpose, then there is no suggestion or motivation to make
the proposed modification.

MPEP § 2143.01, 8th Ed., Rev. 3, pp 2100-137 (August 2005).

As noted above storing two files instead of one would
render Parker unsatisfactory for its intended purpose of
minimizing storage. Accordingly, even if the Examiner
disregards Applicant's remarks concerning the teaching of the
references, the MPEP requirements demonstrate that the

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combination is improper and so a prima facie obviousness rejection has not been established.

The Third Reference Is Also Misinterpreted And Is Unrelated To The Other Two References.

Gross is directed to "Electronic Document Proofing System." Parker is directed to "Intelligent Data Inventory and Asset Management System Method and Apparatus." Shimbo is directed to "File Editing System and Shared File Editing System with File Content Secrecy, File Versioning Management, and Asynchronous Editing." As noted above, the rejection picks pieces out of Gross and combines those pieces with Parker without explaining how Parker would still work to minimize storage or any teaching in the prior art that one of skill would modify the electronic document proofing system based on the unrelated features of Parker. The reliance on the third reference is similarly misplaced.

First, two different aspects are taken from Shimbo. Paragraph 89 is directed at "asynchronous editing without using the locking" while paragraphs 253 and 254 described "the role of count memory unit 905," and "An exemplary data structure of the data stored in the count memory unit 905." Neither description is related to retrieval of an earlier version from a single file that stores both the earlier and the current versions. Accordingly, asynchronous editing without locking and a data structure that does even include the versions, but instead a file ID field and a count array address field is unrelated to Parker and the rejection fails to explain what would be modified in Parker and then how that further modification would be added to Parker. Instead, the rejection stated:

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. . . would have given those skilled in the art the
tools <u>to retrieve the most current version</u> of a document
regardless of the status. (Emphasis Added)

This motivation has nothing to do with the recited claim
language <u>"retrieval of said at least one earlier version for</u>
<u>said subsequent use is independent of a status of said current</u>
<u>version."</u> Being able to retrieve the most current version of a
document regardless of the status provides no motivation with
respect to retrieval of an earlier version. Thus, not only
does the rejection fail to explain what would be changed in
Parker and how, but also the rationale of the motivation to be
able "to retrieve the most current version" goes against the
explicit claim language as recited in Claim 1. This motivation
reduces the claim language to a gist and ignores explicit claim
limitations. Accordingly, the obviousness rejection is not
well founded for multiple reasons, any one of which is
sufficient to overcome the rejection. Applicant requests
reconsideration and withdrawal of the obviousness rejection of
Claim 1.

Claims 2 to 4 depend from Claim 1 and so distinguish over
the combination of references for at least the same reasons as
Claim 1. Applicant requests reconsideration and withdrawal of
the obviousness rejection of each of Claims 2 to 4.

With respect to the obviousness rejection of Claim 5, the
above comments concerning Parker and Claim 1 are incorporated
herein by reference. Also, Paragraph 76 of Parker describes
encrypting both the delta and the file. First, as noted with
respect to Claim 1, this teaches away from storing both
versions in their entireties. Second, the delta and the file
are both encrypted, which teaches away from storing in
different forms as in Claim 5. Accordingly, Claim 5
distinguishes over the combination of references for multiple
reasons. Applicant requests reconsideration and withdrawal of
the obviousness rejection of Claim 5.

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Claim 6 includes language similar to Claim 1. Thus, the comments above with respect to Claim 1 are directly applicable to Claim 6 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 6.

Claims 7 to 8 depend from Claim 6 and so distinguish over the combination of references for at least the same reasons as Claim 6. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 7 to 8.

Claim 9 includes language similar to Claim 1. Thus, the comments above with respect to Claim 1 are directly applicable to Claim 9 and are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 9.

Claims 10 to 11 depend from Claim 9 and so distinguish over the combination of references for at least the same reasons as Claim 9. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 10 to 11.

Claim 12 includes language similar to Claim 1. Thus, the comments above with respect to Claim 1 are directly applicable to Claim 12 and are incorporated herein by reference. Applicant submits that Claim 12 distinguishes over the combination of references. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 12.

Claims 13 to 15 depend from Claim 12 and so distinguish over the combination of references for at least the same reasons as Claim 12. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claim 13 to 15.

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Claims 1 to 15 remain in the application. For the foregoing reasons, Applicant respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant.

CERTIFICATE OF TRANSMISSION
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. 571-273-8300, on June 2, 2006.

_____ June 2, 2006
Rivkah Young   Date of Signature

Respectfully submitted,

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